

Remarks

In response to the Office Action of 28 March 2001, Applicant hereby respectfully requests reconsideration of the restriction requirement relating to the above-identified application.

Claims 4-6 and 23-24 (Groups I and III) have been provisionally canceled by this amendment. The invention described by remaining claims 7-14 and 27-33 (Group II) is hereby provisionally elected.

Reiteration of the Patent Office Restriction Requirement

The Examiner states that the inventions are distinct, each from each other, in that the inventions of groups I, II, and III are unrelated and that these inventions have different functions. Specifically, the Examiner indicates that:

Group I is an apparatus requiring a solution containing anthracene and not a polymer;

Group II is an apparatus requiring a solution of anthracene and a polymer in the solution;
and

Group III is a method not requiring a solution of anthracene and/or a polymer disposed in the solution.

The Examiner states that it would be a burden to search for the specifics for each group when they are not required for each group.

In addition, the Examiner states that the inventions of Group II and of the combination of Groups I and II are related as process and apparatus for its practice. To show another way in which the inventions are distinct, the Examiner indicates that MPEP 806.05(e) describes how inventions are distinct if it can be shown that either:

(1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used for another and materially different process.

Here, the Examiner asserts that the process as claimed can be practiced by another materially different apparatus, such as one not requiring a solution containing anthracene and/or a polymer in the solution.

The Examiner indicates that the inventions are distinct for these reasons and that because the search required for Groups I and II is not required for Group III, restriction is proper.

In addition, the Examiner states that because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction as indicated is proper.

Applicant's Response to the Patent Office Restriction Requirement

Applicant traverses this requirement.

The Manual of Patent Examining Procedure (MPEP) section 803 states that:

“If the search and examination of an entire application can be made without **serious burden**, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”. (bold added)

Applicant has provisionally elected claims 7-14 and 27-33 (Group II). Claim 7, the independent claim of this group, includes the following elements:

CLAIM 7

An apparatus comprising:

- a solution containing anthracene;
- a polymer disposed in said solution, said polymer having the characteristic of changing its volume in response to a change in pH; and
- a source of visible light for irradiating said solution with light of a wavelength and of an intensity to establish a pH change in said solution so that when said solution is irradiated with said visible light said polymer undergoes a change in volume.

Group I's provisionally non-elected independent claim 4 contains the following elements:

CLAIM 4

An apparatus comprising:

- a solution containing anthracene; and
 - a source of visible light
- in which said source of visible light is used to irradiate said solution at a wavelength and of an intensity to establish a pH change in said solution.

Group III's provisionally non-elected independent claim 23 contains the following:

CLAIM 23

A method comprising:

- forming a solution of a compound that exhibits a change in pH upon irradiation with visible light; and
- changing said pH in said solution by irradiating said compound with said visible light so that said compound is elevated from a ground state energy level to a higher

singlet state energy level to a triplet state energy level.

Applicant asserts that, in order for the responsibilities of the patent application examination process to be fulfilled, a prior art search corresponding to the provisionally elected Claim 7 and its dependent claims must be made from the perspective of both 35 U.S.C. 102 and 35 U.S.C. 103.

This search compels an examination of **all** of the elements of provisionally **non-elected** independent claims 4 and 23 as well as the claims dependent thereon.

For this reason, no reasonable person could find a serious burden imposed upon the Examiner by searching and examining the entire application including all of the claims cited.

The Examiner has indicated that the inventions of Groups I, II and III are distinct from each other as they are unrelated. MPEP sections 806.04 and 808.01 are cited by the Examiner wherein it is asserted to be indicated that:

“Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects.”.

In the instant case, the Examiner asserts that the inventions have different functions. No assertion is made however that the inventions are “not disclosed as capable of use together”.

As indicated earlier, the MPEP points out that even if an application includes claims that are independent or distinct, the search and examination of the application must present a serious burden to the Examiner. As Applicant stated above, no such burden is apparent.

The Examiner indicates that the claim limitations are different from each other and are not required for each of the groups. At the onset, it is a requirement of U.S. patent law that

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claims differ from each other. Otherwise they are subject to being rejected on the basis of multiplicity or what technically means “redundancy of claiming the invention”.

The Examiner asserts that it will be a burden to search for the specifics for each group “when they are not even required for each Group”. This may very well be a burden, but this is a burden that is concomitant with the responsibility of a thorough and complete examination. This is what Applicant has paid for. Though it is a matter of degree, the MPEP requires that an Examiner show a **serious burden** will be imposed should they fully search and examine the application. As previously stated, Applicant fails to see how such a “serious” burden will be created. Properly searching and examining the provisionally elected Group II claims **will require** a search of all of the elements of the remaining Group I and III claims.

To further illustrate distinctness, the Examiner categorizes the inventions of Group III and the combination of Groups I and II as process and apparatus for its practice. Here, the Examiner cites MPEP section 806.05(e), wherein the following is contained:

“The inventions can be shown to be distinct if it can be shown that ... (1) the process as claimed can be practiced by another materially different apparatus....”.

For reasoning, the Examiner states that the process as claimed can be practiced by another materially different apparatus such as one **not** containing an anthracene solution or anthracene solution with a polymer disposed in it.

MPEP section 806.05(e) states that:

“The burden is upon the examiner to cite reasonable examples that recite material differences.”.

Applicant asserts that the Examiner has not set forth a reasonable example. Applicant

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considers the requirement of the cited MPEP section to be one of setting forth a positive example versus a negative, in other words, providing an example of a materially different apparatus that can be used to practice the claimed process. None was given.

The Examiner indicates that the inventions are distinct for the reasons given above and because the search required for the combination of Groups I and II is not required for Group III.

Assuming that this reasoning is correct, it implies that Groups I and II deserve single group standing. The Examiner is asked to reconsider this.

Finally, the Examiner indicates that "Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper."

While Applicant recognizes the above quote to be largely a "form" paragraph, its statement is drawn from conclusive reasoning. In describing related inventions, MPEP section 808.02 under the category of "separate status in the art" provides the following:

"Even though they are classified together each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status and also of a separate field of search."

Applicant asserts that this evidence has not been brought forward.

As described in the above remarks, Applicant asserts that the requirement for restriction is improper. It is therefore respectfully requested that this requirement be reconsidered and withdrawn.

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Any inquiry concerning this case should be directed to Applicant's attorney, Mr. Peter Lipovsky at (619) 553-3001.

Respectfully submitted,

by



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